

REMARKS/ARGUMENTS

New claims 21-23 are supported throughout the specification as originally filed. See, e.g., specification page 1, lines 26-30, page 2, lines 24-34, and page 3, lines 37-38. No new matter has been entered.

Present Claim 11 relates to a process for combating acarids in the storage of cereals, comprising placing the cereals in contact with a powder comprising more than 40% by weight of sodium bicarbonate. This claim, by its explicit terms, requires the placing of cereals in contact with a powder comprising sodium carbonate.

The rejection of Claims 11-20 over Misato in view of “Applying Pesticides Correctly” and Knight is traversed.

Misato describes a fungicide and fruit storage disease preventing composition. Col. 1, lines 15-18. The reference states that sodium bicarbonate has a fungicidal effect on plant diseases (col. 1, lines 37-38) but cannot be used alone as a fungicide due to inferior adhesiveness and spreadability (col. 1, lines 47-49). As a result, Misato uses sodium bicarbonate in combination with a surfactant, the combination to be used as a fungicide on vegetables and fruits (col. 1, lines 53-55 and col. 2, lines 39-49).

What Misato does not disclose or suggest is that sodium bicarbonate has acaricidal effects, nor does the reference suggest the use of sodium bicarbonate for combating acarids (or for combating anything else, for that matter) in cereals, and thus the reference does not suggest the placing of cereals in contact with a powder comprising sodium carbonate, as presently claimed. As noted above, the requirement in the pending claims of placing cereals in contact with a powder comprising sodium carbonate is an active step of the present invention method, and not an intended function or use. In this regard, the patentability of the present method claims is not limited solely to the patentability of the composition used. To the contrary, the discovery of a new use for an old composition based on an unknown

property of the composition is patentable as a process. See, e.g., *In re Hack*, 114 USPQ 161, 163 (CCPA 1957) and MPEP 2112.02. To hold otherwise contravenes the Definitions section of U.S. patent law as set forth in 35 U.S.C §100 (emphasis added):

35 U.S.C. 100 Definitions.

When used in this title unless the context otherwise indicates -

(a) The term "invention" means invention or discovery.

(b) **The term "process"** means process, art, or method, and **includes a new use of a known process, machine, manufacture, composition of matter, or material.**

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

(e) The term "third-party requester" means a person requesting ex parte reexamination under section 302 or inter partes reexamination under section 311 who is not the patent owner.

"Applying Pesticides Correctly" does not remedy the defects of Misato, as this reference only discusses the application of pesticides under various conditions and does not disclose or suggest that sodium bicarbonate has acaricidal effects, or that it should be used in cereals.

Finally, Knight relates to the treatment of insects, rather than acarids, the two being different in kind.<sup>1</sup> Insects have an exoskeleton made of different articulated plates,<sup>2</sup> and col. 2, lines 56-63 of Knight shows that the mechanism of action of his disclosed composition critically depends on and works between these plates to enter the body. To the contrary, acarids do not have primary body segmentation. That is, their skeleton is in one piece. Accordingly, and due to the mechanism of action in Knight, the composition described

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<sup>1</sup> See, for example, the attached materials.

<sup>2</sup> *Id.*

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therein would be considered ineffective for acarids as the locus of action is not present. In fact, in the present invention the composition is believed to act only at the external surface of the acarid. See, e.g., specification page 2, lines 24-34.

Accordingly, and in view of the deficiencies in even the combination of Misato, “Applying Pesticides Correctly” and Knight, Applicants submit that the references fail to present a *prima facie* case of unpatentability. As such, the rejection over these references should be reconsidered and withdrawn, and the case passed to Issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/07)